

FERENCE & ASSOCIATES

400 Broad Street
Pittsburgh, Pennsylvania 15143
Phone: (412) 741-8400
Fax: (412) 741-9292
Web: www.ferencelaw.com

RECEIVED
CENTRAL FAX CENTER

DEC 17 2004

USPTO FACSIMILE COVER SHEET

To: Commissioner for Patents
Fax Number: (703) 872-9306
Date: December 17, 2004
Pages: 4 pages (including this cover sheet)

MESSAGE:

INFORMATION TRANSMISSION METHOD AND SYSTEM

Application No. 09/802,252
Examiner G. Neurauter
Art Unit 2143

Response to Restriction Requirement

JP920000032US1
(590.050)

THE INFORMATION CONTAINED IN THIS COMMUNICATION IS CONFIDENTIAL, MAY BE ATTORNEY-CLIENT PRIVILEGED, MAY CONSTITUTE INSIDE INFORMATION, AND IS INTENDED ONLY FOR THE USE OF THE ADDRESSEE. UNAUTHORIZED USE, DISCLOSURE OR COPYING IS STRICTLY PROHIBITED AND MAY BE UNLAWFUL.

IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR,
PLEASE IMMEDIATELY NOTIFY US ON (412) 741-8400.

Atty. Docket No. JP920000032US1
(590.050)

RECEIVED
CENTRAL FAX CENTER
DEC 17 2004

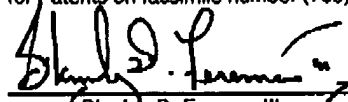
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Ono
Serial No. : 09/802,252 Examiner : G. Neurauter
Filed : March 8, 2001 Art Unit : 2143
For : INFORMATION TRANSMISSION METHOD AND
SYSTEM

December 17, 2004

RESPONSE TO RESTRICTION REQUIREMENT

I hereby certify that this correspondence and any documents referred to as enclosed therewith are being transmitted by facsimile to the Commissioner for Patents on facsimile number (703) 872-9306 on December 17, 2004.


Stanley D. Ference III
Reg. No. 33,879

December 17, 2004
Date of Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is responsive to the Office Action dated November 17, 2004, for the above-identified application.

The Examiner has asserted that Claims 1 and 4-7, drawn to methods, a system, software product, and program storage device to transmitting information to an information terminal network (Group I), and Claims 2 and 3, drawn to methods of

Atty. Docket No. JP920000032US1
(590.050)

transmitting information to an information terminal connected to a network (Group II) are each directed to distinct inventions. The Examiner has required Applicant to elect one group of claims for prosecution.

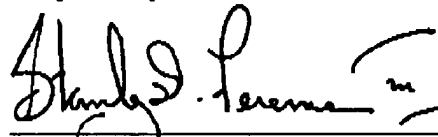
The asserted basis for the restriction requirement is "Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as using a program other than a license key to disable at least part of the function of a downloaded program." Applicant respectfully traverses the restriction requirement. Accordingly, Applicant respectfully requests the restriction requirement be withdrawn and all claims be examined at this time. In the event the restriction requirement is not withdrawn, Applicant provisionally elects the claims of Group I (e.g., Claims 1 and 4-7).

Applicant, however, also asserts that even if the restriction requirement is not withdrawn, the claims of both Groups I and II should be examined at the same time under MPEP § 803 ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions"). The Office asserts that as the inventions of Groups I and II "have acquired separate status in the art as shown by their different classification, restriction for examination purposes is proper." Different classifications, however, do not mean both classes would not be searched. See MPEP § 904.02(a) ("In outlining a field of search, the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature that may have

Atty. Docket No. JP920000032US1
(590.050)

material pertinent to the subject matter as claimed. Every subclass, digest, and cross-reference art collection pertinent to each type of invention claimed should be included, from the largest combination through the various subcombinations to the most elementary part. The field of search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.") In this regard, the Office's attention is directed to U.S. Patent No. 6,775,782 which issued on August 10, 2004 and is assigned to the assignee of the present invention (International Business Machines Corporation). This recently issued U.S. Patent was searched in multiple classes and is classified in multiple classes; in fact, the multiple classes for searching and classification include the two classes identified in the outstanding Restriction Requirement. In view of this past Office practice, there can be no credible assertion there would be a serious burden in searching and examining the claims of both Groups I and II in the same application.

Respectfully submitted,



Stanley D. Ference III
Registration No. 33,879

Customer No. 35195
FERENCE & ASSOCIATES
400 Broad Street
Pittsburgh, Pennsylvania 15143
(412) 741-8400
(412) 741-9292 - Facsimile

Attorneys for Applicant